

## **Remarks**

### **I. Introduction**

This Supplemental Response is to correct the application data shown at the top of the Response filed on October 25, 2005 and to correct claims 14 and 20 as presented in that Response. The arguments for patentability of claims 14-28 provided in the Response filed on October 25, 2005 have not been changed and are repeated herein for the Examiner's convenience.

### **II.**

Applicant is in receipt of the Office Action dated April 26, 2005. At the time the application was examined, claims 1-13 were pending. Per this Supplemental Response, claims 1-13 were cancelled and new claims 14-28 were added to better define the invention. Claims 14-28 will be discussed in light of the Examiner's bases for rejecting claims 1-13 for indefiniteness under 35 U.S.C. § 112, second paragraph, anticipation under 35 U.S.C. § 102 (b), and the judicially-created doctrine of obviousness-type double patenting. Applicant will demonstrate herein that new claims 14-28 overcome each of the Examiner's bases for rejection, and the application is in condition for allowance and should be passed to issue.

### **III. Claims 14-28 Are Definite under 35 U.S.C. §§ 112, Second Paragraph**

The Examiner will likely contend that 14-28 claims are indefinite under 35 U.S.C. §§ 112, second paragraph, because of the recitation of the terms "rigid," "semi-rigid," "flexible," and "non-deformable." In particular, the Examiner will likely assert that these terms are indefinite because these terms "[are] not defined by the claim, the specification does not provide a standard for the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention." Further, the Examiner will likely contend that "it is unclear what range of Rockwell hardness of the material of the second section is required in order to be considered as terms "rigid," semi-rigid, or flexible, or non-deformable." Applicant submits that the claims are definite as will be shown.

New claims 14-28, like cancelled claims 1-13, include the terms “rigid,” “semi-rigid,” “flexible,” and “non-deformable.” Applicant has attached as Attachment A excerpts from the Ninth New Collegiate Dictionary. These excerpts demonstrate that each of the terms that the Examiner has contended is indefinite is a very common term that a person of ordinary skill in the art would understand with sufficiency to make and use the present invention. The attached excerpts make plain that a person of ordinary skill in the art would clearly understand the scope of the claims when “rigid,” “semi-rigid,” or “flexible,” or “non-deformable,” is used. As such, claims 14-28 would be definite in the hands of a person of ordinary skill in the art. Noting this, Applicant overcomes the Examiner’s indefiniteness rejection under 35 U.S.C. § 112, second paragraph, as to the use of the terms “rigid,” “semi-rigid,” “flexible,” and “non-deformable,” and respectfully requests that this rejection not be raised with regard to new claims 14-28.

#### **IV. The Anticipation Rejection Under 35 U.S.C. § 102 (b) is Traversed**

The Examiner rejected claims 1-13 for anticipation under 35 U.S.C. § 102 (b) based separately on U.S. Patent No. 4,708,676 to Lin (“Lin”), U.S. Patent No. 4,875,386 to Dickinson (“Dickinson”), and U.S. Patent No. 3,937,629 to Hamasaka (“Hamasaka”). Applicant believes that the Examiner will likely raise these same rejections against claims 14-28. As such, Applicant will demonstrate that these prior art references do not anticipate claims 14-28.

The Examiner cites Figure 7 of Lin as anticipating claims 14 and 20 of the present invention. In doing so, the Examiner does not rely on what is shown and described in the application but what he believes it teaches. However, the Examiner cites no portion of the specification to support this contention, as he must do.

It is to be noted that what is shown in Figure 7 of Lin is the buoy ring turned upside down. In the normal use of the buoy ring, air chambers 22 are underwater and used to provide the ring with a stable directional effect. (Lin, 2:33-39) Further, when buoy ring 2 is used in the inverted position shown in Figure 7, air chambers 22 are used as “gripping means” (Lin, 3:57-59) not fatigue-relieving elements. It would be commonly understood by a person of ordinary skill in the art that “gripping means” would bring about the opposite effect of fatigue relief.

Applicant submits that buoy ring 2 in Figure 7 does not disclose or render obvious the steering wheel of claims 14-28. Accordingly, Lin does not teach the steering wheel of claims 14-28.

The buoy ring of Figure 7, also does not teach the first and second sections of the apparatus of the present invention that includes the functional features of the second section as specified in claims 14 and 20. These functional features include, but are not limited to, the second section deforming substantially out of interference with the use of the steering wheel when pressure is applied that is equal to, or greater than, the deforming pressure. These features are not shown or appreciated by Lin. As such, Applicant submits that this is another ground that supports that Lin does not anticipate or render obvious the invention of claims 14 and 20.

Claims 15-19 and 21-28 depend from claims 14 and 20, respectively. Each of the dependent claims adds additional features to claims 14 and 20 from which it ultimately depends. As such, claims 15-19 and 21-28 are not anticipated or rendered obvious by Lin for the same reasons as claims 14 and 20.

Applicant has set forth bases that clearly demonstrate that claims 14-28 are not anticipated or rendered obvious by Lin. Therefore, Applicant requests that the Examiner not raise an anticipation rejection against claims 14-28 based on Lin.

## **V. U.S. Patent No. 4,875,386 to Dickinson Does Not Anticipate Claims 14-28**

The Examiner rejected claims 1 -13 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 4,875,386 to Dickinson (“Dickinson”). Applicant anticipates that the Examiner will raise this same rejection against claims 14-28. Applicant submits it would be improper to do so.

Dickinson is directed to a “cruise control device” for motorcycles. It is disposed only on the throttle handlegrip of a motorcycle. The device is a lever-type device that “releasably attaches to the existing rotating throttle handlegrip, and is rotatably adjustable, so as to permit the motorcycle operator to maintain a desired constant throttle setting only by pressure from the heel of the palm of his hand and the adjoining wrist area.” (1:66-2:5)

The device consists of a “single piece of stiff resilient material, having a circular segment which is shaped circularly so as to grip the outer end of the throttle handlegrip, and a lever segment which extends beneath the heel of the palm and adjoining wrist ... in the normal operating position of the throttle handlegrip.” (2:7-13) The downward application of pressure on the lever segment “neutralizes the return force of the carburetor return-to-idle springs, permitting the operator to maintain a constant throttle opening without having to grasp the throttle handlegrip.” (2:15-19) The circular segment tightens as the lever is pushed down. (2:29-35) The lever segment of the device does not deform under downward pressure but remains stiff so that it will continue to rotate the throttle as more downward pressure is applied to increase speed.

If the entirety of the configurations of the Dickinson device shown in the drawings and described in the specification is considered, it is plain that none of them apply to a steering wheel. This makes sense since the intent of the device is to provide a member that can be used as a positive connection to the throttle handlegrip for turning it to increase and decrease speed. Since, Dickinson is not directed to a steering wheel, claims 14 and 20 are clearly distinguishable. This is a strong, clear basis for the Dickinson not anticipating or rendering obvious claims 14 and 20.

Given the foregoing, the Examiner should not raise an anticipation rejection against claims 14 and 20 based on Dickinson.

Claims 15-19 and 21-28 depend from claims 14 and 20, respectively. Each of the dependent claims adds additional features to claims 14 and 20 from which it ultimately depends. Therefore, claims 15-19 and 21-28 are not anticipated or rendered obvious by Dickinson for the same reasons as claims 14 and 18.

Applicant has demonstrated that claims 14-28 are not anticipated or rendered obvious by Dickinson. Thus, Applicant respectfully requests that the Examiner not raise an anticipation rejection against claims 14-28 based on Dickinson.

## **VI. U.S. Patent No. 3,937,629 to Hamasaka Does Not Anticipate Claims 1-38**

The Examiner has rejected claims 1-13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,937,629 to Hamasaka (“Hamasaka”). Again, Applicant

believes the Examiner will raise this same objection based on Hamasaka against claims 14-28.

Hamasaka is directed to handlebar extenders. The device has two parts: a movable bracket and an extension (rod) that is “rigidly and integrally” joined to the bracket. The rod is rigid and extends from the bracket. This rod is bent into a handle at the end.

(Abstract) The extensions may be “positioned out of the way or positioned for use with little bother.” (1:32-35)

The first part, “band 22,” is secured at the desired location with “bolt 44 and nut 46.” (1:51-60) The rod connects to band 22. The rod is not for fatigue relief. The extensions (bracket and rod) may be moved to positions 18’ and 20’ out of the way and secured in that position, but Hamasaka does not show that the rods are “deformable” with respect to the bracket. (2:17-21)

The bracket and rod are welded together at 32 to form a single integrated unit. (2:30-40) There is no resiliency in the device. It is secured and used in the secured position. There is no support in Hamasaka for the Examiner’s contention that the device may be moved once secured without unbolting it, moving it, and then rebolting it. Once an extension is in the secured position for use, it would not deform so that it would not interfere with the operator if it got in the way. (See operation, 3:2-14)

Hamasaka does not anticipate claims 14 and 20 given that it is not directed in any way to a steering wheel. Moreover, there is nothing in Hamasaka that in any way indicates it applies to a steering wheel. This alone forms a strong, clear basis for Hamasaka not being held to anticipate claims 19 and 20. As such, the Examiner should not raise an anticipation rejection against claims 14 and 20 based on Hamasaka.

Claims 15-19 and 21-28 depend from claims 14 and 20, respectively. Each of the dependent claims adds additional features to claims 14 and 20 from which it ultimately depends. As such, claims 15-19 and 21-28 are not anticipated or rendered obvious by Hamasaka for the same reasons as claims 14 and 20.

Noting the foregoing, the Examiner should not raise an anticipation rejection against claims 14-28 based on Hamasaka.

## **VII. Obviousness-Type Double Patenting**

The Examiner will likely raise the judicially-created doctrine of obviousness-type double patenting against claims 14–28 in view of parent application U.S. Serial No. 10/720,821. This rejection can be overcome by filing a terminal disclaimer in favor of the parent application. To overcome this rejection, Applicant will file a terminal disclaimer upon the Examiner’s allowance of the claims.

## **VIII. New Prior Art**

In parent application U.S. Serial No. 10/720,821, the Examiner has raised five new patents in rejecting the claims in that application. These patents are listed in the attached PTO Form 1449. These references are U.S Patent No. 1,575,848 to Laubach (“Laubach”), U.S Patent No. 1,834,537 to Shipley (“Shipley”), U.S Patent No. 2,118,540 to Van Arsdel (“Van Arsdel”), U.S Patent No. 2,134,020 to Anson (“Anson”), and U.S Patent No. 2,335,256 to Berzer (“Berzer”). Applicant submits that claims 14-28 are patentable over these references taken alone or in combination.

Of the five patents, Laubach, Anson, Van Arsdel, and Berzer, among other things, disclose an element that engages the hand of the driver that is disposed outward or inward from the steering wheel rim in the plane across of the face of the steering wheel. As set forth in claims 14-28, the second section of the fatigue-relieving apparatus is disposed outward at an angle to the plane across the face of the steering. This distinguishes claims 14-28 from each of these references.

The remaining reference Shipley is also distinguishable from claims 14-28. Shipley has a knob or handle that is fixed to the steering wheel. The knob or handle extends from the steering wheel and is grasped so that the hand is around the knob or handle. The knob or handle will rotate about its longitudinal axis. The knob or handle is rigidly fixed to the steering wheel and cannot be moved out of interference with the operation of the steering wheel as can the present invention as shown in Figure 4 of the present application. Support for the fact that the knob or handle in Shipley is only contemplated to be a fixed, non-movable attachment of the steering wheel is found at page 2, column 1, lines 15 to 89. At this section of Shipley, it describes fixing the knob or handle to the steering wheel and the spinning of the knob or handle in the hand of the driver in this fixed position. If the knob or handle of Shipley was to be moved out of

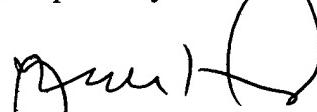
interference as set forth in claims 14-28, it would be contrary to teaching of Shipley and would break the device. As such, Shipley does not anticipate claims 14-28 nor render them obvious.

## **IX. Conclusion**

In this Supplemental Response, Applicant has traversed each of the Examiner's bases for rejecting the now pending claims 14-28 under 35 U.S.C. § 112, second paragraph, for indefiniteness, 35 U.S.C. § 102 (b) for anticipation, and obviousness-type double patenting. Having traversed each of these basis for rejection, the present application is in condition for allowance. The present invention is new, non-obvious and useful. Reconsideration and allowance of the claims are respectfully requested.

Dated: November 3, 2005

Respectfully submitted,



Wayne M. Kennard  
Attorneys for the Applicant

Wilmer Cutler Pickering Hale and Dorr LLP  
60 State Street  
Boston, MA 02109  
Tel: 617-526-6183  
Fax: 617-526-5000  
Attorney Docket Number: 114089.121US1